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09/557,196

04/21/2000

Stephen G. Perlman

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7590

01/30/2008

WORKMAN NYDEGGER/MICROSOFT

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60 EAST SOUTH TEMPLE

SALT LAKE CITY, UT 84111

EXAMINER

NGUYEN, CHAU T

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* STEPHEN G. PERLMAN  
9

10  
11 Appeal 2007-1734  
12 Application 09/557,196<sup>1</sup>  
13 Technology Center 2100  
14

15  
16 Decided: January 30, 2008  
17  
18

19  
20 Before ALLEN R. MACDONALD, ROBERT E. NAPPI, and  
21 CAROLYN D. THOMAS, *Administrative Patent Judges*.

22  
23 THOMAS, C., *Administrative Patent Judge*.  
24

25 DECISION ON APPEAL

26 I. STATEMENT OF THE CASE

27 Appellant appeals under 35 U.S.C. § 134 from a non-final rejection  
28 of claims 1-19 entered January 11, 2006. We have jurisdiction under  
29 35 U.S.C. § 6(b).

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<sup>1</sup> Application filed April 21, 2000. The real party in interest is Microsoft Corporation.

1           We reverse.

2                                   A. INVENTION

3           Appellant invented a system, method, and computer readable medium  
4 for tuning channels within a home entertainment system by connecting  
5 multiple consumer electronics devices to a central electronics device with an  
6 internal tuner. The central electronics device uses an electronic  
7 programming guide (EPG) to differentiate scrambled signals from non-  
8 scrambled signals. The scrambled signals are routed to an electronic device  
9 for descrambling . . . The non-scrambled signals are tuned by the tuner  
10 within the central electronics device. (Spec., Abstract.)

11

12                                   B. ILLUSTRATIVE CLAIM

13           The appeal contains claims 1-19. Claims 1, 5, and 8 are independent  
14 claims. As best representative of the disclosed and claimed invention,  
15 Claim 1 is reproduced below:

16           1.     In a home entertainment system including a central device  
17 coupled to a plurality of electronic devices, wherein the plurality of  
18 electronic devices includes a display device and a descrambler, and wherein  
19 the central device manages the operation of the plurality of electronics  
20 devices, a method for tuning channels that are requested by a user for  
21 display on the display device, the method comprising the steps for:

22                   receiving user input at the central device, wherein the user input  
23 selects a channel that corresponds to a signal carrying programming, and  
24 wherein the signal is received by the entertainment system;

25                   using electronic programming guide data stored at the central  
26 device to determine whether the signal is scrambled or non-scrambled,

1 wherein both the scrambled and the non-scrambled signals have to be tuned  
2 before being displayed;

3 if the signal is determined from the electronic programming  
4 guide data to be scrambled, performing the steps for:

5 routing the scrambled signal from the central device to  
6 the descrambler;

7 and

8 using the descrambler to descramble and tune to one or  
9 more channels of the scrambled signal for display on the display device; and

10 if the signal is determined from the electronic programming  
11 guide to be non-scrambled, performing the step for:

12 using an internal tuner that is located at the central device  
13 to tune to one or more channels of the non-scrambled signal for display on  
14 the display device, and such that the non-scrambled signal can be displayed.

15  
16 C. REFERENCES

17 The references relied upon by the Examiner in rejecting the claims on  
18 appeal are as follows:

19	Kurtz	US 5,574,440	Nov. 12, 1996
20	Macrae	US 6,745,391B1	Jun. 1, 2004
21			(Filed Apr. 16, 1999)
22			

23 D. REJECTION(S)

24 In a Non-Final Rejection mailed on January 11, 2006, after a request  
25 for continued examination, the following rejection was presented and is  
26 before us for review:

1           Claims 1-19 are rejected under 35 U.S.C. § 103(a) as being  
2 unpatentable over Kurtz in view of Macrae.

3  
4                                   II. PROSECUTION HISTORY

5           Appellant appealed from the non-final rejection and filed an Appeal  
6 Brief (Br.) on August 30, 2006. The Examiner mailed an Examiner's  
7 Answer (Answer) on November 28, 2006. Appellant filed a Reply Brief  
8 (Reply Br.) on January 26, 2007.

9  
10                                  III. ISSUE(S)

11           Whether Appellant has shown that the Examiner erred in rejecting  
12 claims 1-19 as being obvious over the combination of Kurtz and Macrae.

13  
14                                  IV. FINDINGS OF FACT

15           The following findings of fact (FF) are supported by substantial  
16 evidence.

17                                   *Kurtz*

18           1. Kurtz discloses a “[s]witching apparatus 10 . . . wherein two  
19 implements such as a television receiver and a VCR are operated in  
20 conjunction with two sources, for example, the output of a cable converter  
21 box and non-premium cable programming suited for a cable ready TV  
22 tuning system.” (Col. 4, ll. 49-54.)



1 nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir.  
2 1998)).

3 “Section 103 forbids issuance of a patent when ‘the differences  
4 between the subject matter sought to be patented and the prior art are such  
5 that the subject matter as a whole would have been obvious at the time the  
6 invention was made to a person having ordinary skill in the art to which said  
7 subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727,  
8 1734 (2007). The question of obviousness is resolved on the basis of  
9 underlying factual determinations including (1) the scope and content of the  
10 prior art, (2) any differences between the claimed subject matter and the  
11 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called  
12 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18  
13 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these  
14 questions might be reordered in any particular case, the [*Graham*] factors  
15 continue to define the inquiry that controls.”)

## 16 17 VI. ANALYSIS

### 18 *Common Feature In All Claims*

19 Our representative claim, claim 1, recites, *inter alia*, “using an  
20 internal tuner that is located at the central device to tune . . . the non-  
21 scrambled signal.” Independent claims 5 and 8 recite similar limitations.  
22 Thus, the scope of each of the independent claims includes that there is a  
23 tuner located at a central device for tuning non-scrambled signals.

*The Obviousness Rejection*

We now consider the Examiner's rejection of claims 1-19 under 35 U.S.C. § 103(a) as being obvious over the combination of Kurtz and Macrae.

Appellant contends that "using an internal tuner located at the central device to tune non-scrambled signals is directly contrary to the teachings of Kurtz" (Br. 21) and "all of the 'programming and viewing features' are expressly those of the VCR and television, and thus do not teach a tuner at the central device" (Reply Br. 7). Appellant further contends that "[n]owhere does Kurtz teach a tuner located at the central device, and the Examiner's argument that such a tuner is well-known in the art is both unsupported by any evidence and contradicted by the Examiner's own statement." (Reply Br. 8.) We agree.

The Examiner found that:

"Kurt discloses . . . where the signal source selected is a non-premium (non-scramble) channel input, the viewer is provided the use of all the various built-in programming (tuner) and television receiver to tune the signal before being displayed. Also, it's well-known in the art that either scrambled or non-scrambled signal must be tuned before being displayed, they have to be tuned either by set top box, television, or any device. Therefore signals must be tuned before being displayed is an inherent feature at the central device of the applicant's invention." (Answer 13.)

While we agree with the Examiner that it is known that both scrambled and non-scrambled signals must be tuned before being displayed,

1 we find that the Examiner has not established that the non-scrambled signals  
2 must inherently be tuned at the central device. "Inherency, . . . may not be  
3 established by probabilities or possibilities. The mere fact that a certain  
4 thing may result from a given set of circumstances is not sufficient." *In re*  
5 *Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal  
6 quotation marks omitted).

7 The Examiner admits that they (non-scrambled signals) have to be  
8 tuned either by set top box, television, or any device. We agree that various  
9 devices can be used to tune the non-scrambled signals. However,  
10 Appellant's invention requires "using an internal tuner that is located at the  
11 central device to tune . . . the non-scrambled signal."

12 Kurtz discloses using either a TV tuner or a VCR tuner (FF 1-2) to  
13 tune signals. The Examiner fails to find that the TV or VCR of Kurtz  
14 represents a central device, i.e., a device that manages the operation of a  
15 plurality of electronic devices. Instead, the Examiner relies upon Kurtz's  
16 switching apparatus 10 to represent the claimed central device. (Answer 4.)  
17 However, there is no factual basis to support the Examiner's finding that  
18 Kurtz switching apparatus 10 includes an internal tuner for tuning non-  
19 scrambled signals.

20 Appellant further contends that "using a central device to tune the  
21 programming signals is directly contrary to Kurtz's stated goal of allowing  
22 the VCR and television to tune the programming signals" (Reply Br. 9). We  
23 agree.

1 Kurtz discloses that its technique returns many of the advantageous  
2 features of the receiving units (TV and VCR), including remote actuation, to  
3 the television viewing public (FF 3). Thus, we find the Examiner's finding  
4 that Kurtz switching apparatus 10 includes an internal tuner is unsupported.

5 Furthermore, the Examiner does not address whether Macrae  
6 discloses such a central device feature, nor do we find such a feature in  
7 Macrae. Although Macrae discloses detecting whether a signal is  
8 unscrambled, once detected the unscrambled signal is merely visually  
9 distinguished on the guide (FF 4). Macrae fails to disclose tuning the  
10 unscrambled signal using an internal tuner in a central device, as set forth in  
11 the claimed invention.

12 A rejection based on section 103 must rest upon a factual basis rather  
13 than conjecture, or speculation. "Where the legal conclusion [of  
14 obviousness] is not supported by the facts it cannot stand." *In re Warner*,  
15 379 F.2d 1011, 1017 (CCPA 1967). *See also In re Lee*, 277 F.3d 1338, 1344  
16 and *Kahn*, 441 F.3d at 988. Here, we find that the Examiner is resting the  
17 obviousness conclusion on mere conjecture and speculation that Kurtz  
18 discloses a central device with an internal tuner for tuning non-scrambled  
19 signals, rather than on a factual basis.

20 For at least the reason noted *supra*, we find that the Appellant has  
21 shown an error in the Examiner's rejection. Therefore, we reverse the  
22 rejection of claim 1 and of claims 2-19, which stand therewith.

23

VII. CONCLUSIONS

We conclude that Appellant has shown that the Examiner erred in rejecting claims 1-19.

VIII. DECISION

In view of the foregoing discussion, we reverse the Examiner's rejection of claims 1-19.

REVERSED

rwk

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